

## **II. Remarks**

### **A. Status of the Claims**

Claims 1-27 are pending in this application. New claims 25-27 have been added to more particularly point out the invention. Applicants acknowledge with appreciation that claims 23 and 24 are allowed.

Claims 1 and 16 are amended to more particularly claim the invention. Support for the amendment is found in the specification at page 13, lines 2-6, and in Figures 1-3.

Support for new claims 25-27 can be found in the specification as originally filed on page 17, lines 6-21 and in Figures 5 and 6.

Applicants assert that no new matter has been added to the claims by these amendments.

### **B. 35 U.S.C. §112 Rejection**

1. Responsive to the 35 USC§ 112, first paragraph, rejections of Claims 1-22, for allegedly failingly to provide an enabling disclosure for the first sample processing device being "uncovered", Applicants have amended claim 1 by deleting the term "uncovered", and inserting the phrases "said collar is positioned on the outer perimeter edge of said first sample processing device", and "said collar and said second seal is positioned on the outer perimeter edge of said first sample processing device. Applicants respectfully submit that claim 1, as well as the other remaining claims, meet the specific requirements of 35 USC§ 112, first paragraph.

2. Responsive to the 35 USC§ 112, second paragraph, rejections of Claims 1-22, as being indefinite for allegedly failingly to particularly point out and distinctly claim the subject matter of the invention, Applicants have amended claim 1, as discussed supra.

Applicants respectfully submit that claim 1, as well as the other remaining claims, meet the specific requirements of 35 USC§ 112, second paragraph.

### **C. 35 U.S.C. §102 Rejection**

Claims 1-3, 5-9, 11, 12 and 16-21 are rejected as allegedly anticipated by U.S. Pat. No. 6,159,368 to Moring et al. (hereinafter "Moring"). Applicants respectfully traverse.

The standard for anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir.1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Amended claim 1 recites in part: a collar; a base; a first sample processing device; a collection plate or target tray, stacked below said first sample processing device to form an integral stacked unit, said stacked unit positioned between said collar and said base, and said collar is positioned on the outer perimeter edge of said first sample processing device; (emphasis added) a first seal between said collar and said base; and a second seal between said first sample processing device and said collar, and said second seal is positioned on the outer perimeter edge of said first sample processing device (emphasis added).

Amended claim 16 recites in part, said collar is positioned on the outer perimeter edge of said first sample processing device (emphasis added).

Claim 13 recites in part: a base in sealing engagement with said collar, the base comprising an outer peripheral flange and a side wall which together form a peripheral groove and wherein a portion of the flange contacts a slot formed in the collar. Applicants do not believe Moring discloses this element. In this regard the Office is invited to consider Figure 3 in Moring once again, with particular focus on (38), which the Office believes is a collar and (51), which the Office believes is a base. Applicants note that there is no peripheral flange, nor is there a slot in the collar which is contacted by the flange.

Accordingly, Applicants request the withdraw of these rejections.

**D. 35 U.S.C. §103 Rejection**

Claims 4 and 22 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,159,368 Moring et al.(hereinafter, "Moring") in view of U.S. Patent No. 5,498,545 to Vestal (hereinafter, "Vestal"). Applicants respectfully traverse the rejections.

Claims 4 and 22 stand rejected as allegedly obvious in light of Moring in view of Vestal. The Office Action asserts that Moring teaches all the elements of the claims, but admits that none of these references teach a MALDI device as the second device. According to the Office, Vestal teaches a mass spectrometer system for analyzing multiple samples. The Office Action contends that Vestal discloses a system including a sample plate for holding samples on pins in wells of a plate. The Office Action concludes it would have been obvious to combine Vestal with the device of Moring. The Office Action further states that one would use the plate of Vestal as the collection plate in order to load the collection plate for MALDI analysis of the samples. Applicants respectfully traverse the rejection.

### **The Prima Facie Case Requirement**

The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP §2142. MPEP §2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine what the reference teaches. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations." The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141. Applicants respectfully contend that the Office Action has not met its burden in establishing a prima facie case of obviousness.

For the reasons set forth above, Moring does not teach or suggest every claim limitation of claim 4 or 22. Vestal does nothing to cure this defect. Accordingly the claims are not prima facie obvious.

Moreover, Applicants note that the Office Action has not pointed to anything in the cited references that would motivate the skilled artisan to make the suggested

combination. The references themselves must suggest the desirability of making the suggested combination. Applicants believe there is nothing of record that suggests such motivation. Accordingly, Applicants respectfully request withdrawal of the rejection.

**III. CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request the reconsideration and withdrawal of the rejections, and the timely allowance of the pending claims. Applicants believe that the above response is a complete response to the present office action. If however the Examiner believe that some requirement has been missed or not completely answered, the Examiner is invited to contact Applicants' attorney at the number below. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account.

Respectfully submitted

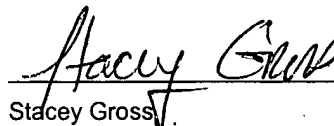


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The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on **January 14, 2008**.

  
Stacey Gross